

REMARKS

Review and reconsideration on the merits are requested.

Formalities

Applicants appreciate the Examiner acknowledging receipt of the certified copies of the priority document from the International Bureau (there is one priority document) and returning PTO/SB/08 forms, one initialed, and one not initialed. The references listed on PTO/SB/08 previously filed June 3, 2005 (not initialed) were re-filed on May 6, 2008.

Claim Objections

Applicants amend claim 50 as suggested by the Examiner.

Claim Rejections - 35 U.S.C. § 112

Claims 1-51 were rejected under the above section essentially on the ground that the specification did not reasonably provide enablement for preventing diseases associated with hyperglycemia.

“Preventing” language is canceled from the claims.

Withdrawal is requested.

The Prior Art

Hossain et al (Hossain). Fully identified on page 8 of the Action and in PTO-892.

The Rejection

Claims 1-51 were rejected under 35 U.S.C. § 102(a) as being anticipated by Hossain.

The Examiner’s position on the art will not be repeated here except as necessary to an understanding of Applicants’ traversal which is now presented.

Traversal

While Hossain discloses that (+)-catechin, (-)-epicatechin gallate (ECg) and (-)-epigallocatechin gallate (EGCg) inhibit the response of SGLT1, Hossain does not teach or suggest anything about GLUT2 and/or GLUT5 inhibition or any advantages of an SGLT1 inhibitor showing no GLUT2 and/or GLUT5 inhibitory effect. Therefore, it is respectfully submitted that the present invention is not disclosed or suggested by Hossain, and, thus, is novel and unobvious.

Although the Examiner states that “Since these compounds are shown to have noncompetitive inhibition of SGLT1, it would be believed that they inherently comprised the non-inhibiting GLUT characteristics.” on page 8 in the Action, Applicants are unaware of any art or background knowledge in the art establishing there is any relation between noncompetitive inhibition of SGLT1 and non-inhibition of GLUT 2 and/or GLUT5. Thus, Applicants respectfully submit that the Examiner has provided no rationale/evidence tending to establish or establishing that the compounds disclosed by Hossain inherently have non-inhibition of GLUT2 and/or GLUT5 characteristics.

It is well established that where an inherency-type rejection is presented, the Examiner carries the initial burden to provide some rationale to support a conclusion of inherency. Here the Examiner has provided no such rationale.

The Examiner’s attention is directed to MPEP 2112 IV, Rev. 6, Sept. 2007 at page 2100-48, left column;

“In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art”.

Withdrawal is requested.

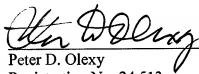
Request for Interview

Applicants would propose to submit claims containing a proviso clause that they would like to discuss with the Examiner. If the undersigned does not hear from the Examiner in about two weeks, the undersigned will call the Examiner.

Withdrawal of all rejections and allowance is requested.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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